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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,921	07/17/2003	Rockne W. Behne	PTG 02-83-4	3083

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SUITER WEST PC LLO
14301 FNB PARKWAY
SUITE 220
OMAHA, NE 68154

EXAMINER

DEXTER, CLARK F

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,921

Applicant(s)

BEHNE, ROCKNE W.

Examiner

Clark F. Dexter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 18-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/12/03; 8/19/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I (claims 1-17) in the reply filed on January 24, 2005 is acknowledged. Claims 18-21 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.

Information Disclosure Statement

2. The information disclosure statement filed on September 12, 2003 has been received and the references listed thereon have been considered.

Drawings

3. The drawings are objected to because in Figure 4, the lead line for numeral 206 is inaccurate and should extend to the lifting shoe (i.e., the cylindrical component).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

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consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the lifting shoe in direct engagement with the sliding tension bracket as set forth in claims 4 and 11 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application as described above.

Claim Rejections - 35 USC § 112, 1st paragraph

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 2 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The disclosure does not appear to provide sufficient support for the pin being removable from the first end of the tension crank. In fact, it appears that no description has been provided for the specific connection between the pin and the tension crank.

7. Claims 4 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification and drawings do not appear to provide support for the lifting shoe being in direct engagement with the sliding tension bracket. Rather, support is provided for these components being interconnected by a threaded shaft.

Claim Rejections - 35 USC § 112, 2nd paragraph

8. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 5-6, the recitation "the lifting shoe ... being received within the upper arm" renders the claim vague and indefinite since the invention is being positively defined in terms of the upper arm which is not part of the claimed invention; in line 8, the recitation "operationally coupled" renders the limitation vague and indefinite as to what is being set forth and appears to be inaccurate, particularly since the pin and lifting shoe do not appear to be coupled, but rather only appear to contact one another; in line 11,

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the recitation "the tension crank being received within the upper arm" renders the claim vague and indefinite since the invention is being positively defined in terms of the upper arm which is not part of the claimed invention; in line 16, the recitation "releases tension to" is vague and indefinite as to what is being set forth and appears to be inaccurate, and it seems that "to" should be changed to --from-- or the like; in line 17, the recitation "applies tension from" is vague and indefinite as to what is being set forth and appears to be inaccurate, and it seems that "from" should be changed to --to-- or the like.

In claim 6, line 2, the recitation "a plurality of positions" is vague and indefinite as to what is being set forth, particularly as to whether "positions" refers to those set forth in claim 1 or to other such positions.

In claim 7, the recitation "wherein the amount of tension applied to the band saw blade may vary" is vague and indefinite as to what is being set forth.

In claim 8, line 4, "further" is vague and indefinite as to what it refers (i.e., further in view of what?), and it seems that it should be deleted or the like; in line 5, structural cooperation is not positively provided between the sliding tension bracket and the upper arm, and it is suggested to delete "for" or the like; in line 18, the recitation "releases tension to" is vague and indefinite as to what is being set forth and appears to be inaccurate, and it seems that "to" should be changed to --from-- or the like; in line 19, the recitation "applies tension from" is vague and indefinite as to what is being set forth and appears to be inaccurate, and it seems that "from" should be changed to --to-- or the like.

In claim 10, the recitation "a second blade tensioning device" renders the claim vague and indefinite as to what disclosed structure it refers.

In claim 13, line 2, the recitation "a plurality of positions" is vague and indefinite as to what is being set forth, particularly as to whether "positions" refers to those set forth in claim 8 or to other such positions.

In claim 14, the recitation "wherein the amount of tension applied to the band saw blade may vary" is vague and indefinite as to what is being set forth.

In claim 15, lines 3-4 are vague and indefinite as to what is being set forth - for example, it is not clear as to what disclosed structure "means for operationally engaging the upper band wheel" refers, particularly in view of the subsequent recitation "means for applying a tension to the band saw blade", which "means to apply tension" clause is also unclear as to what disclosed structure it encompasses/refers.

In claim 16, lines 2 and 4, each occurrence of "further" is vague and indefinite as to what it refers (i.e., further in view of what?), and it seems that it should be deleted or the like; in lines 2-3, the recitation "comprises the blade tensioning device" renders the claim vague and indefinite, particularly in view of claim 15 since it is not clear how the blade tensioning device of claim 16 can be part of itself (i.e., the blade tensioning device of claim 15); in lines 7-8, the recitation "a lifting shoe ... being received within the upper arm" renders the claim vague and indefinite since the invention is being positively defined in terms of the upper arm which is not part of the claimed invention; in line 10, the recitation "operationally coupled" renders the limitation vague and indefinite as to what is being set forth and appears to be inaccurate, particularly since the pin and lifting

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shoe do not appear to be coupled, but rather only appear to contact one another; in line 13, the recitation "the tension crank being received within the upper arm" renders the claim vague and indefinite since the invention is being positively defined in terms of the upper arm which is not part of the claimed invention.

In claim 17, lines 1-2, the recitation "the means for determining a tension" lacks antecedent basis and is vague and indefinite as to what disclosed structure it refers.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-9 and 11-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Lasar, pn 2,969,815.

Lasar discloses a quick-pin blade tensioning device and a band saw with a quick-pin blade tensioning device with every structural limitation of the claimed invention including a sliding tension bracket (e.g., 20, 22), a lifting shoe (e.g., 28), a pin (e.g., 56), a tension crank (e.g., 26), and a tension handle (e.g., 32).

Claim Rejections - 35 USC § 102/103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 10 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lasar, pn 2,969,815.

Lasar discloses a quick-pin blade tensioning device and a band saw with a quick-pin blade tensioning device with every structural limitation of the claimed invention including a second blade tensioning device (e.g., the threads at the top of 26 that are received in component 94).

In the alternative, if it is argued that Lasar does not explicitly disclose such a second blade tensioning device, the Examiner takes Official notice that it is old and well known to provide second blade tensioning devices on band saws for various well known benefits; for example, to provide macro and micro tension-adjustment capabilities. Therefore, it would have been obvious to one having ordinary skill in the art to provide a second blade tensioning device on the band saw of Lasar for the well known benefits including that described above.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-

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4505. The examiner can be reached Monday, Tuesday, Thursday and Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571)272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Clark F. Dexter
Primary Examiner
Art Unit 3724

cf
May 2, 2005